



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/250,940	02/18/1999	JAY H. CONNELLY	2207/6019	2643

7590 04/23/2003

MICHELLE M. CARNIAUX
KENYON & KENYON
ONE BROADWAY
NEW YORK,, NY 10004

EXAMINER

TRAN, TRANG U

ART UNIT

PAPER NUMBER

2614

DATE MAILED: 04/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/250,940

Applicant(s)

CONNELLY ET AL.

Examiner

Trang U. Tran

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-16, 18-27, 29-36, 38 and 41-48 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

- 5) ☐ Claim(s) _____ is/are allowed.

- 6) ☒ Claim(s) 2-16, 18-27, 29-36, 38 and 41-48 is/are rejected.

- 7) ☐ Claim(s) _____ is/are objected to.

- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed Feb. 07, 2003 have been fully considered but they are not persuasive.

In re pages 9-10, applicants argue that, with respect to claim 16, in the Michaud patent, the VCR codes are received and stored in a set top box and these VCR codes are not used to control a target device while an output device provides an output (e.g., the television) as a function of the program within which the VCR codes are sent. Accordingly, the Michaud patent does not described "wherein the at least one target device is controlled as a function of the command signal while an output device provides an output as a function of the data signal".

In response, the examiner respectfully disagrees. Michaud discloses in col. 5, lines 21-60 that the VCR codes are used to control the VCR and the video signal received is provided to the television receiver. Thus, Michaud does indeed disclose the claimed "wherein the at least one target device (VCR of Michaud) is controlled as a function of the command signal (VCR codes of Michaud) while an output device (television receiver of Michaud) provides an output as a function of the data signal (television signal of Michaud).

In re pages 10-11, applicants again argue that, with respect to claim 34, the Michaud patent does not described "providing by the output device an output as a function of the data signal while the at least one target device is controlled using the command signal".

Art Unit: 2614

In response, the examiner respectfully disagrees. First at all, rule 37 C.F.R. 111(b) requires that applicant MUST "distinctly and specifically point out errors" in the examiner's action. As discussed above with respect to claim 16, Michaud does disclose the claimed "providing by the output device (television receiver) an output as a function of the data signal (television signal) while the at least one target device (VCR) is controlled using the command signal (VCR codes).

2. Applicant's arguments with respect to claims 41, 2-15, 43-44, 27, 29-33, 38 and 45-48 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 41, 2-15, 43-44, 27, 29-33, 38 and 45-48 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claim 41 contains subject matter such as "a command device generating a command signal **associated** with the data signal" which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Independent claim 13 contains subject matter such as "a transmitter coupled to The modulator and transmitting the transmission signal, wherein data in the command signal and data in the data signal are **linked** so that when the data signal is used at a receiving end of the transmission signal, the at least one target device is controlled as a function of the command signal while an output device at the receiving end provides an output as a function of the data signal" which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Independent claim 27 contains subject matter such as "providing a command signal and a data signal to a first device, the command signal being **associated** with the data signal" which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Independent claim 38 contains subject matter such as "providing a command signal and a data signal to a first device, the command signal being **associated** with the data signal" which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Independent claim 45 contains subject matter such as "receiving a data signal including content, receiving a command signal, including commands, **associated** with the content" which was not described in the specification in such a way as to reasonably

convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Claim Objections

5. Claims 12, 43-44 objected to because of the following informalities: They depend on the independent claim 1 which has been canceled. Appropriate correction is required.

6. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 45, 44, 45-47 been renumbered 44-48, respectively.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 16, 18-26 and 34-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Michaud (US Patent No. 6,057,874).

In considering claim 16, Michaud discloses all the claimed subject matter, note 1) the claimed a receiver receiving a transmission signal is met by the tuner 113 and the out of band data receiver 115 (Fig. 3, col. 3, lines 29-65), 2) the claimed a demodulator extracting a first signal from the transmission signal is met by the tuner 113 (Fig. 3, col. 3, lines 29-65), 3) the claimed a command decoder decoding the first signal into the command signal, wherein the at least one target device is controlled as a function of the command signal is met by the video processor 118 (Fig. 3, col. 3, lines 29-65).

In considering claim 18, the claimed further comprising: a command dispatcher providing the command signal to a corresponding target device is met by the IR remote interface 123 (Fig. 3).

In considering claim 19, the claimed a controller generating a control signal using the command signal to control the at least one target device is met by the system processor 101 (Fig. 3, col. 3, lines 29-65), and the claimed a memory unit coupled to the controller and storing the command signal is met by the RAM 121 (Fig. 3, col. 3, lines 29-65).

In considering claim 20, the claimed further comprising: a filtering device coupled to the controller, the filtering device controlling and selecting the command signal as a function of predetermined variables is met by the graphical user interface (GUI) (Fig. 4, col. 4, lines 14-27).

In considering claim 21, the claimed wherein the filtering device is implemented as a software application, the software application being stored in the memory unit is met by the software program (Figs. 4-8, col. 4 line 14 to col. 6, line 65).

In considering claim 22, the claimed wherein the predetermined variables are adjusted according to a predetermined procedure is met by the software program (Figs. 4-8, col. 4 line 14 to col. 6, line 65).

In considering claim 23, the claimed wherein the command transmitter provides the command signal to the output device is met by the data transmitter receiver 112 (Fig. 2, col. 3, lines 20-29).

In considering claim 24, the claimed further comprising: a transmitting device transmitting a data to a predetermined device, the data being provided by at least one of the filtering device and the at least one target device is met by the software program for controlling the VCR (Figs. 4-8, col. 4 line 14 to col. 6, line 65).

In considering claim 25, the claimed wherein the transmitting device includes a modem is met by col. 3, lines 23-29.

In considering claim 26, the claimed wherein the predetermined variables include a profile of a user is met by Fig. 7, col. 5, line 62 to col. 6, line 27.

In considering claim 34, Michaud discloses all the claimed subject matter, note 1) the claimed obtaining the first address and a second address from a first device is met by the information providers 14 (Fig. 1, col. 2, line 57 to col. 3, line 9), 2) the claimed providing the first and second addresses to a command device is met by the information providers 14 (Fig. 1, col. 2, line 57 to col. 3, line 9), 3) the claimed providing a message, located at the first address to the first device using the command device, the message including the second address, transmitting the message, located at the first address, to a second device is met by the headend 12 which receives video, audio and data content

Art Unit: 2614

from remote service providers 14 and retransmits this information over the CATV transmission network 22 (Figs. 1 and 2, col. 3, lines 4-29), 4) the claimed extracting the second address from the message using the second device is met by the set top terminal 20 (Figs. 1 and 3, col. 3, line 30 to col. 4, line 13), 5) the claimed storing the second address using a memory unit is met by ROM 119 or RAM 121 (Fig. 3, col. 3, line 30 to col. 4, line 13), 6) the claimed providing a command signal and a data signal to the first device is met by the headend 12 which receives video, audio and data content from remote service providers 14 and retransmits this information over the CATV transmission network 22 (Figs. 1 and 2, col. 3, lines 4-29), 7) the claimed transmitting the command signal, located at the second address, to the second device is met by the headend 12 which receives video, audio and data content from remote service providers 14 and retransmits this information over the CATV transmission network 22 (Figs. 1 and 2, col. 3, lines 4-29), 8) the claimed controlling the at least one target device using the command signal is met by the VCR (col. 4, line 14 to col. 6, line 65), 9) the claimed transmitting the data signal to the second device is met by the headend 12 which receives video, audio and data content from remote service providers 14 and retransmits this information over the CATV transmission network 22 (Figs. 1 and 2, col. 3, lines 4-29), 10) the claimed providing the data signal to an output device by the second device is met by the TV set 21 (Fig. 1), and 11) the claimed providing, by the output device, an output as a function of the data signal while the at least one target device is controlled using the command signal is met by the VCR.

In considering claim 35, the claimed wherein the message includes a predetermined data of the command and data signal is met by the headend 12 which receives video, audio and data content from remote service providers 14 and retransmits this information over the CATV transmission network 22 (Figs. 1 and 2, col. 3, lines 4-29).

In considering claim 36, the claimed wherein the at least one target device selects the command signal as a function of the predetermined data is met by the VCR (col. 4, line 14 to col. 6, line 65).

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 2614

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Trang U. Tran** whose telephone number is **(703) 305-0090**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **John W. Miller**, can be reached at **(703) 305-4795**.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:


(703) 872-9314 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

TT TT

August 8, 2002


JOHN MILLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600